

SUPPORT FOR THE AMENDMENTS

Claims 1-7 have been amended.

Claims 8-10 have been added.

Support for the amendment of Claims 1-7 is provided by the corresponding claims as originally filed and the paragraph bridging pages 7-8 of the specification. Claims 8-10 find support in original Claims 4-6.

No new matter has been added by the present amendments.

REMARKS

Claims 1-10 are pending in the present application.

The rejection of Claims 1-7 under 35 U.S.C. §102(b) over Kishimoto et al is obviated by amendment.

In the response herein, Applicants have amended Claim 1 to define the metal oxide complex powder as having a primary particle diameter of said metal oxide complex powder is 1  $\mu\text{m}$  or less. Applicants submit that Kishimoto et al neither disclose nor suggest a metal oxide complex powder having a primary particle diameter as presently claimed. As such, Kishimoto et al cannot anticipate the claimed invention.

Further, Applicants submit that the claimed invention would not be obvious in view of the disclosure of Kishimoto et al. The metal oxide complex powder of the present invention is obtained by polymerizing a polymerizable and unsaturated group-containing monomer with the use of a polymerization initiation group introduced onto the surface of at least one metal oxide (selected from zinc oxide, titanium oxide and cerium oxide). In other words, in the present invention, a graft polymerization starts on the surface of the metal oxide.

With respect to product-by-process limitations, we note that the Examiner properly notes that these limitations are not typically taken into account when examining a claim and examination is typically based of the final product without consideration of the process by which they are produced. Indeed, with respect to the product-by-process limitation of the presently claimed invention, the courts have enunciated that: "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a

product of the prior art, the claims is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

There are two important aspects to the foregoing. First, the products must be identical or an obvious variant thereof. Second, patentability of a product may not depend on its method of production, but the method of production cannot be disregarded if that method provides a distinct structure or product. Indeed, the Board and the Courts have said as much, which is set forth in MPEP §2113 in relevant part:

“The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where... the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g. *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979)... The Board stated that the dispositive issue is whether the claimed factor exhibits any unexpected properties compared with the factor disclosed by the prior art.” (citing *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989)

Kishimoto et al merely disclose a dispersion polymerization, which is equivalent to Comparative Synthesis Example 1 of the present application in which the obtained metal oxide complex powder has a primary particle diameter of 3 µm (see Table 1 on page 15 of the specification), which is clearly outside the scope of the claimed invention and, thus, structurally distinct from the claimed invention. Further, Applicants direct the Examiner’s attention to Table 1 on page 15 of the specification where it is clearly shown that the synthesis examples of the present invention have a superior UV shielding effect ( $\Delta T$ ) as compared to Comparative Synthesis Example 1. Moreover, Table 2 on page 17 of the specification clearly shows that the synthesis examples of the present invention have a superior stability upon storage at 25°C for 7 days as measured by the change in viscosity.

In view of the foregoing, Applicants submit that the claimed invention is not anticipated by or obvious in view of Kishimoto et al. Withdrawal of this ground of rejection is requested.

The rejections of Claim 7 under 35 U.S.C. §101 and under 35 U.S.C. §112 are obviated by amendment. Applicants have rewritten Claim 7 in proper method form. Withdrawal of these grounds of rejection is requested.

The objection to Claim 6 under 37 C.F.R. §1.75(c) is obviated by amendment. Applicants have amended Claim 6 to remove multiple dependencies. Withdrawal of this ground of objection is requested.

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

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